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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,555	06/26/2003	Wassana Apichatachutapan	12164	7282

28484 7590 12/14/2004

BASF CORPORATION
LEGAL DEPARTMENT
1609 BIDDLE AVENUE
WYANDOTTE, MI 48192

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,555

Applicant(s)

APICHATCHUTAPAN ET AL.

Examiner

John m Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0603.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Kageoka et al.(6,204,300) & EP-0,934,962, each taken individually (Equivalents to be referred to collectively as Kageoka et al.).

Kageoka et al. disclose preparations of polyurethane foams prepared from isocyanates and blends of polyols which read on the polyols of applicants' claims and the chain extenders as defined by applicants' claims and additives (see the examples, as well as, the entire document). Without distinguishing definition, polyols of Kageoka et al. meet the function of chain extension in a manner which is sufficient to meet the limitations of the instant claims. Cell openers, chain extenders, and crosslinkers are additives well known to the art which are readily envisioned from the teachings of Kageoka et al.

The rejection beginning on the following page is set forth as an alternative to the above rejection:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageoka et al. in view of Khanna (4,209,593), Kelly et al.(4,670,477), and Nishida et al.(6,136,879)

Kageoka et al. disclose preparations of polyurethane foams prepared from isocyanates and blends of polyols which read on the polyols components of applicants' claims, as well as, additives known to the art (see the examples, as well as, the entire document).

Kageoka et al. differs from applicants' claim in that chain extenders are not particularly required. However, Khanna (see column 3 line 63 – column 4 line 2, as well as, the entire document) discloses the employment of chain extenders in soft flexible foams for the purpose of imparting their chain extending effect and increasing the modulus without changing crosslink density. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the crosslinkers of Khanna in the preparations Kageoka et al. for the purpose of imparting their chain extending effect and increasing the

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modulus without changing crosslink density in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Kageoka et al. differs from applicants' claim in that cell-openers are not required. However, Kelly et al. discloses the known use of cell-openers, extensively inclusive of those such as mineral oil, in polyurethane foam synthesis for the purpose of imparting their cell-opening effect (see column 2 lines 39-43). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the cell-openers of Kelly et al. in the preparations of Kageoka et al. for the purpose of imparting their cell-opening effect in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Kageoka et al. differs from applicants' claim in that monohydric alcohols are not required. However, Nishida et al. (see column 2 lines 48 et seq., as well as the entire document) discloses monohydric alcohols to be useful in soft polyurethane synthesis for the purpose of preventing shrinkage and other effects in articles realized. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the monohydric alcohols of Nishida et al. in the preparations of Kageoka et al. for the purpose of imparting their shrinkage reducing and other effects in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Kageoka et al. differs from applicants' claim in that crosslinking agents are not required. However, Nishida et al. (see column 17 lines 41-42, as well as the entire document) discloses crosslinker as defined by applicants' claims to be useful in soft polyurethane synthesis for the purpose of imparting their crosslinking effect in articles realized. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the crosslinkers of Nishida et al. in the preparations of Kageoka et al. for the purpose of imparting their crosslink density increasing effect to articles realized in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Kageoka et al. differs from applicants' claim in that prepolymers are not employed. However, Nishida et al. (see column 16 lines 19-27, as well as the entire document) discloses the employment of isocyanate-terminated prepolymers in soft polyurethane synthesis for the purpose of aiding in handling of the reactants. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed isocyanate-terminated prepolymers as isocyanate contributing reactants in the preparations of Kageoka et al. formed in the manner prescribed by Nishida et al. for the purpose of imparting their handling improving effects to reactants used in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10/606,825. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in make-up and contents of materials employed and properties of realized products to a degree and in a manner which would have been obvious to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of

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copending Application No. 10/916,241. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in make-up and contents of materials employed and properties of realized products to a degree and in a manner which would have been obvious to one having ordinary skill in the art.

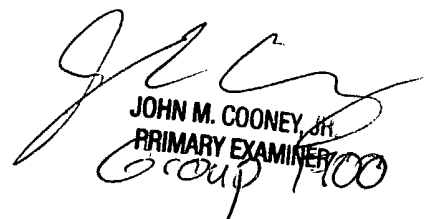
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Neff et al. (6,710,096) and Fukuda et al.(3,454,504) are cited for their disclosures of relevant materials in the related arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 100